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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,621	03/27/2007	Michael Christopher James	GJE-7618	4379
23557 7590 09/16/2008 SALIWANCHIK LLOYD & SALIWANCHIK A PROFESSIONAL ASSOCIATION PO BOX 142950 GAINESVILLE, FL 32614-2950				
EXAMINER JARRELL, NOBLE E				
ART UNIT		PAPER NUMBER		
1624				
MAIL DATE		DELIVERY MODE		
09/16/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/580,621

**Applicant(s)**

JAMES ET AL.

**Examiner**

NOBLE JARRELL

**Art Unit**

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/02)  
Paper No(s)/Mail Date 12/26/06
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Arguments***

1. Claims 1-11 are being examined in the current office action.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. What "nefopam analogue" is referred to in this claim? Applicants do not provide any definitions or structures or antecedent basis for this terminology.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-6 and 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Blaschke et al. (*Archiv der Pharmazie*, **1987**, 320(4), 341-7, abstract). Blaschke et al teach the resolution of a racemic mixture of nefopam using dibenzoyltartaric acid (see abstract). Claims 10-11 are anticipated in addition to the method claims because the bis(nefopam) salt of dibenzoyltartaric acid will be formed in the process of racemic resolution.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rexall Drug and Chemical Co. (DE 1620198, published 6 April 1972), in view of Treiber et al (US4269833, issued May 26, 1981).

*Determining the scope and contents of the prior art*

Rexall Drug and Chemical Co. teaches the preparation of a racemic mixture of nefopam (beispiel 1, pages 7-9).

Treiber et al. teach the resolution of single enantiomers of 7-ethyl-(3-methoxyphenol)-4-methyl-hexahydro-1,4-oxazepine using O, O-dibenzoyltartaric acid (example 9, column

8). It is stated that specific enantiomers of 7-ethyl-(3-methoxyphenol)-4-methyl-hexahydro-1,4-oxazepine can be obtained by using specific forms of O, O-dibenzoyltartaric acid. Treiber et al. also teach that nefopam and -ethyl-(3-methoxyphenol)-4-methyl-hexahydro-1,4-oxazepine are both analgesic compounds (column 1, lines 4-15).

*Ascertaining the differences between the prior art and the claims at issue*

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The prior art teaches the preparation of a racemic mixture of nefopam and the racemic resolution of 7-ethyl-(3-methoxyphenol)-4-methyl-hexahydro-1,4-oxazepine using O, O-dibenzoyltartaric acid as a resolving agent.

*Resolving the level of ordinary skill in the pertinent art*

One of ordinary skill in the art recognizes that a chemist could try O, O-dibenzoyltartaric acid as a resolving agent based upon the teachings of Treiber et al.

*Considering objective evidence present in the application indicating obviousness or nonobviousness*

Based upon the teachings of Treiber et al., it would be obvious to try using O, O-dibenzoyltartaric acid as a resolving agent analgesic compounds that have heterocyclic components. It is also known that specific enantiomers of the compounds can be obtained by using a specific form of O, O-dibenzoyltartaric acid.

**Conclusion**

9. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NOBLE JARRELL whose telephone number is (571)272-9077. The examiner can normally be reached on M-F 7:30 A.M - 6:00 P.M. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached on (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Noble Jarrell/  
Examiner, Art Unit 1624

**/James O. Wilson/  
Supervisory Patent Examiner, Art Unit 1624**